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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/782,011	02/12/2001	David Leigh Donoho	UNIV0001D2-C	2182
22862	7590	09/22/2004	EXAMINER	
GLENN PATENT GROUP 3475 EDISON WAY, SUITE L MENLO PARK, CA 94025			CARDONE, JASON D	
			ART UNIT	PAPER NUMBER
			2145	

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/782,011	DONOHO ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jason D Cardone	2145	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 June 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)       |
| Paper No(s)/Mail Date _____   | 6) <input checked="" type="checkbox"/> Other: <u>See Attached Office Action</u> . |

## **DETAILED ACTION**

### ***Response to Remarks***

1. This action is responsive to the remarks of the applicant, filed on 6/15/04. Claims 1-13 are presented for further examination.

### ***Double Patenting***

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969). A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b). Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 12, 25-27 and 30 of U.S. Patent No. 6,263,362. Although the conflicting claims are not identical, they are not patentably distinct from each other because they disclose the same subject matter.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dasan, USPN 5,761,662, in view of Rose et al. (hereinafter Rose), USPN 5,724,567.

Regarding claim 1, Dasan discloses a method for inspecting any of the properties computer's configuration, contents of said computer's storage devices, said computer's peripherals, said computer's environment, or remote affiliated computers, comprising the steps of: providing at least one inspector which includes an inspector library and associated methods [ie. user profiles, Dasan, col. 6, lines 1-19]; and evaluating subexpressions with said at least one inspector[ie. using user profile, Dasan, col. 6, lines 20-60];

Dasan does not specifically disclose the inspector performs any of mathematico-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices or remote computers. However, Rose, in the same field of endeavor, discloses an inspector performs any of mathematico-logical calculations, executes computational algorithms, returns the results of system calls, accesses the contents of storage devices, and queries devices or remote computers [ie. server (10), Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62]. It would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate mathematico-logical calculations, taught by Rose, in to the newspaper generator, taught by Dasan, since Rose suggests that text retrieval for users, similar to the text retrieval disclosed by Dasan, can have the ability to direct relevant messages [Rose, col. 1, line 65 - col. 2,

line 16]. One of ordinary skill in the art would have been motivated to modify Dasan to include the mathematico-logical calculations in view of Rose, so that the user may see the most relevant message available.

6. Regarding claims 2 and 3, Dasan-Rose further discloses providing an inspector dispatcher associated with an advice client for continually performing relevance determination; wherein said relevance determination is driven by a database of relevance clauses which can be continually evaluated; and wherein said inspector library contains executable code which is invoked by said inspector dispatcher as part of said relevance determination process, wherein an object, property name, and/or string selector is dispatched to said inspector dispatcher for relevance evaluation using a method dispatch module in accordance with dispatch information contained within a method dispatch table [ie. newspaper generator, Dasan, col. 5, line 53 - col. 6, line 60] [ie. server (10), Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

7. Regarding claim 4, Dasan-Rose further discloses the method dispatch module parsing a clause in a relevance language; generating a list of method dispatches in response to said parsing step, wherein specific methods are called in a specific order with specific argument lists; and systematically carrying out a sequence of method dispatches in an appropriate order [Dasan, col. 5, line 53 - col. 6, line 60] [Rose, col. 6, line 62 - col. 7, line 62].

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8. Regarding claim 5, Dasan-Rose further discloses sending certain relevance clauses to a remote location; evaluating said clauses; and returning said clauses after a user is made aware of what is being transferred', wherein properties of said remote location are learned [Dasan, col. 6, lines 1-19] [Rose, col. 3, lines 37-65 and col. 6, line 62 - col. 7, line 62].

9. Regarding claim 6, Dasan-Rose further discloses the at least one inspector is built into said inspector dispatcher [Dasan, col. 6, lines 20-60].

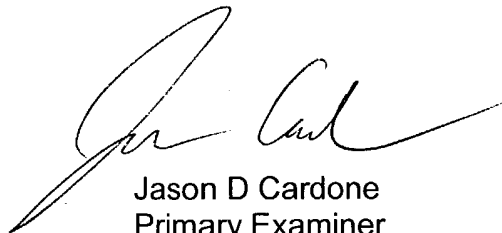
### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason D Cardone whose telephone number is (703) 305-8484. The examiner can normally be reached on Mon.-Thu. (9AM-6PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jack Harvey can be reached on (703) 305-9705. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'J. Cardone', is positioned above the printed name.

Jason D Cardone  
Primary Examiner  
Art Unit 2145

September 17, 2004